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10/031,218	05/07/2002	Marcus Filshie	02597	2627

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SALTER & MICHAELSON
THE HERITAGE BUILDING
321 SOUTH MAIN STREET
PROVIDENCE, RI 029037128

EXAMINER

EREZO, DARWIN P

ART UNIT	PAPER NUMBER
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3773

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/031,218	Applicant(s) FILSHIE ET AL.	
	Examiner Darwin P. Erez	Art Unit 3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action is in response to the applicant's communication filed on 1/27/09.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

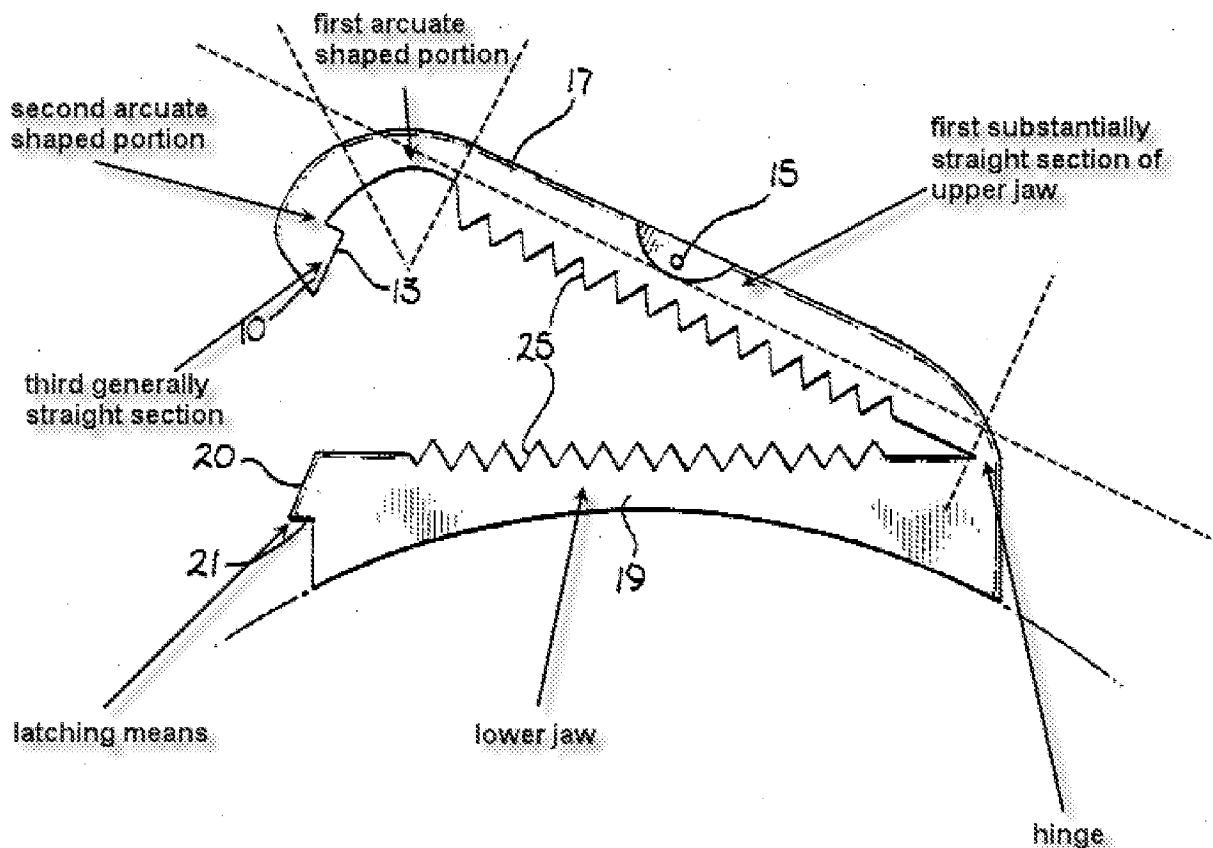
3. Claims 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,519,392 to Lingua.

As seen in the attached figure below, Lingua discloses a surgical clip comprising:

- an elongate upper jaw and an elongate lower jaw attached together at a first hinge end;
- the lower jaw being provided with latching means at an opposite end to the hinge;
- the upper jaw comprising a complex shape comprising:
 - a first substantially straight section adjacent to the hinge,
 - a second arcuate shaped section adjoining the straight section and in which the second arcuate shaped section comprises:
 - a first arcuate shaped portion adjacent to said substantially straight section, and

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- a second arcuate shaped portion adjacent to said first arcuate shaped portion at an opposite end of said first arcuate shaped portion to said substantially straight section,
- wherein said first arcuate shaped portion having a first radius of curvature on at least its outer contact surface that is substantially greater than the radius of curvature of said second arcuate shaped portion which has a second radius of curvature,
- wherein a center of the radius of curvature for both the first and second arcuate shaped portions is located on the same side of the upper jaw
- wherein there is an absence of a straight portion between the first and second arcuate shaped portions.



Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-17 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,519,392 to Lingua in view of US 4,489,725 to Casey et al.

As seen in the attached figure above, Lingua discloses a surgical clip comprising:

- an elongate upper jaw and an elongate lower jaw attached together at a first hinge end;
- the lower jaw being provided with latching means at an opposite end to the hinge;
- the upper jaw comprising a complex shape comprising:
 - a first substantially straight section adjacent to the hinge,
 - a second arcuate shaped section adjoining the straight section and in which the second arcuate shaped section comprises:

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- a first arcuate shaped portion adjacent to said substantially straight section, and
 - a second arcuate shaped portion adjacent to said first arcuate shaped portion at an opposite end of said first arcuate shaped portion to said substantially straight section,
 - wherein said first arcuate shaped portion having a first radius of curvature on at least its outer contact surface that is substantially greater than the radius of curvature of said second arcuate shaped portion which has a second radius of curvature,
 - wherein a center of the radius of curvature for both the first and second arcuate shaped portions is located on the same side of the upper jaw.
- a third generally straight section adjacent to said second arcuate shaped portion, said generally straight section, when in the closed position of the clip interlocking under the latching section of the lower jaw;
 - wherein the third generally straight section is viewed as the distal generally straight section having a free end that is contiguous with the second arcuate shape section;
 - wherein the first arcuate shaped portion has the same width therealong and as measured in the direction of the first radius of curvature;

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- wherein said second arcuate shaped section has the same width therealong and as measured in the direction of the second radius of curvature;
- wherein the upper jaw is distorted to fit within the latch means (see transition from Figs. 3(a) to 3(e);
- wherein the first arcuate shaped portion is contiguous with the second arcuate shaped portion to form a complex contiguous curved shape;
- wherein there is an absence of a straight portion between the first and second arcuate shaped portions;
- wherein the clip is fully capable of being inserted through a tubular member having a dimension bigger than the clip (note that the tubular member is not positively recited in claims 14 and 15);
- wherein the second arcuate shaped section has an arcuate portion on either an outer and inner side thereof.

Lingua discloses all the limitations of the claims except for the clip having a silicone rubber lining on both sides of the jaws; with the first radius of curvature is of the order of three times that of the second radius of curvature; and to the jaws being connected together via a hinge pin.

However, Casey discloses a similar surgical clip having the missing recited limitations. Casey discloses said clip having rubber silicone lining on both sides of the jaws, and wherein the jaws are connected via a hinge pin.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a silicone lining to the jaws of Lingua as it would provide a softer contact surface for the jaws against the tissue, while the serrated tooth of the jaws will provide enough tension on the lining to secure the clip onto the tissues. It also would have been obvious to change the hinge means of Lingua to the hinge means of Casey because both are well known equivalents in the art and substituting one hinge means for another would be a mere obvious design choice to one of ordinary skill in the art.

It also would have been obvious to one of ordinary skill in the art at the time the invention was made to modify curvature of the first or second arcuate shaped portion to have the recited ratio because since it has been held that changing the shape of a working part involves only routine skill in the art. *In re Dailey*; 357 F.2d 669, 149 USPQ 47 (CCPA 1966). It has been held that discovering an optimum value (the ratio of curvature between the first radius of curvature and the second radius of curvature) of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Lingua also discloses the use of a clip closure member (forceps or clamp style tool; col. 2, ll. 14-15) but is silent with regards to the applicator imposing pressure on only the straight section of the clip. However, it would be a mere obvious design choice to one of ordinary skill in the art to modify the device of Lingua to have the applicator only applying pressure on the straight sections of the clip because applying pressure

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only on the straight portions or only on the curved portions will produce the same result of forcing the clip into a clamped position.

Terminal Disclaimer

8. The terminal disclaimer filed on 1/27/09 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,699,258 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

9. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darwin P. Erezzo whose telephone number is (571)272-4695. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Darwin P. Erezzo/
Primary Examiner, Art Unit 3773